

REMARKS

Claims 7-16 are pending in the application.

35 USC § 103:

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoi (U.S. Patent No. 5,168,429) in view of Ishida (U.S. Pat. No. 5,949,565).

The Examiner contends that Hosoi teaches a portable electronic apparatus including the claimed features, except for the claimed light emitting module and light receiving module. In particular, the Examiner acknowledges that Hosoi does not teach a light receiving module in the display which receives a picture signal as light emitted from the light emitting module. Thus, the Examiner cites Ishida for disclosing a light receiving element 48, which the Examiner asserts is mounted in the display member 21. The Examiner also asserts that element 48 receives an image signal as light emitted from a light emitting element 47, when the display member 21 is mounted on the body 2. Applicant respectfully traverses the rejection in view of the following remarks.

First, untaught modifications would be necessary to implement the teachings of Ishida into Hosoi. Rejections under 35 U.S.C. §103 should include:

(1) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;

(2) the difference or differences in the claim over the applied reference(s);

(3) *the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and*

(4) *an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made.*

See MPEP §706.02(j).

A *prime face* case of obvious has not been established because the necessary modifications are not taught and, thus, the invention could not have been obvious. In effect, it is the present inventor who has conceived the idea of providing the claimed combination of elements to obtain the presently disclosed desirable aspects. At least, requirements 3 and 4 noted above are missing because the proposed modifications necessary to arrive at the claimed subject matter are not disclosed in the references nor set forth in the Office Action. In particular, the Office Action does not set forth any actual modifications that would be needed to arrive at the claimed invention. Instead, the grounds of rejection state that “it would have been obvious ...to combine Hosoi’s and Ishida’s inventions.”

The needed modifications are part of the inventive aspects provided by the Applicant, which the Examiner will appreciate are not provided outside of Applicant’s own disclosure.

When the Examiner ponders how Hosoi would be modified, it will become apparent why one would not have made the combination. In particular, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959); (see also MPEP §2144.01).

The applied references are not sufficient to render the claims obvious because the proposed combination would change the principle of operation of Hosoi. In particular, the device of Hosoi uses a fixed connector hole 35 in the main body 3 that mates with the connector 85 of the display 5. The connector hole 35 and connector 85 do not rotate with respect to each other, but rather engage when the non-rotatable unit body 63 of the display is pushed

downwardly onto the main body 3. The screen of the display unit 5 rotates, while the connections between the main body 3 and unit body 63 are still. This permits the display of Hosoi to be removed, while also permitting the display to rotate.

On the other hand, the display of Ishida is not intended to be removed. In fact, it is the light transmitting and receiving configuration of Ishida that keeps the display from being removed. As shown in Figure 2 of Ishida, the boss portion 44 of the display is engaged with the hole 45 of the apparatus body 2 to permit the light transmission element 47 to communicate with the light receiving element 48. This configuration creates a hinge 40 such that the display is locked to the apparatus body 2.

If one were to modify Hosoi to include the light transmitting/receiving elements 47 and 48 of Ishida, they would make the combination in accordance with Ishida's teachings, which is to provide Hosoi with light transmitting/receiving elements in the form of a hinge. However, this configuration in Ishida is not disconnectable - which is completely opposite to that required by Hosoi. Thus, if the teachings of Ishida were applied to Hosoi, then Hosoi would have its principle of operation changed because it would no longer have a display that is readily detachable. The detachable display is a fundamental aspect in Hosoi. Therefore, Hosoi would be rendered unsatisfactory for its intended purpose, which evidences the lack of motivation to combine the references. (See MPEP §2143.01.)

Accordingly, claim 7 is deemed patentable of Hosoi and Ishida, such that the rejection under 35 U.S.C. 103(a) should be withdrawn. The rejection of claims 8-12 should be withdrawn at least due to claims 8-12 depending from claim 7.

NEW CLAIMS:

New claims 13-16 are added to obtain more varied protection for the invention and are deemed patentable over the applied references at least due to their respective dependencies on claim 7.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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